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| EXAMINER | |
|---|---|
| SUHOL, DMITRY | |
| **ART UNIT** | **PAPER NUMBER** |
| 3714 | |

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/621,156 | WEINER ET AL. | |
| | Examiner | Art Unit | |
| | Dmitry Suhol | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/03/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the features encompassed by the phrase "each one of the building blocks is defined for young children in the age range of 3-5" can't be determined. It is unclear what feature defines the building blocks for that particular age group, especially since it appears that applicants clearly states that a variety of age groups may use the claimed methods at page 3, paragraph 0011 and at page 4, paragraph 0017 and that the only thing that would be modified is/are the learning objects used therewith. Furthermore it is unclear what age group is being claimed by the range of 3-5 (i.e. 3-5 years old, month old or another unit of time measure).

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claim is directed to non-statutory subject matter.

In analyzing claims 1-10 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). The preamble of claim 1 characterizes the invention as a "process for assessing and developing an individual's emotional intelligence...". The specification makes clear that the particular "learning object" (toy, game, story, etc.) employed in the process is not important and can be any object (page 7, paragraph 0022). Thus the invention is essentially a species of what care givers and children have done for ages – utilize different objects with educational activities to learn a variety of concepts. Stated differently the invention takes old and conventional educational play and performs that old process by directing it to emotional states.

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that an individual's emotional intelligence will be predictably assessed or developed by the steps set forth. There is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an objective standard. Actual assessment of emotional intelligence, much less actual development of emotional intelligence, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a "tangible" result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). It has been held that "an idea of itself is not patentable, but a new device by which it may be made practically useful is." Rubber-Tin Pencil Co. v. Howard, 87 U.S. 498, 507 (1874). Abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work, but a "practical application" of the concept to produce a "useful" result is patentable. The "abstract idea" exception refers to disembodied plans, schemes, or theoretical methods. An "abstract idea" is utilized in an invention that is a "process, machine, manufacture, or composition of matter" under 35 USC 101, and is "useful" when it has utility. Where the claim covers any and every possible way that the steps may be performed, this is more likely to be a claim to the "abstract idea" itself, rather than a practical application of the idea. For example, in discussing the

mathematical algorithm in Gottschalk v. Benson, the Supreme Court discussed that cases holding that a principle, in the abstract, cannot be patented and then stated:

> Here the "process" claim is so abstract and sweeping as to cover both known and unknown uses of the BCD to pure binary conversion. The end use may...be performed through any existing machinery or future-devised machinery or without any apparatus.

409 U.S. at 68, 175 USPQ at 675. The fact that a claimed method is not tied to a machine, even if the method could be performed by a machine, and that it does not recite a transformation of physical subject matter to a different state or thing, is an indication that the method is a disembodied "abstract idea" and is not a practical application, as broadly claimed. Claims 1-10 describe a process for "assessing and developing an individual's emotional intelligence...". The method as claimed is considered an "abstract idea" because no concrete and tangible means for accomplishing the method is claimed. The method, as claimed, covers any and every possible way of implementing the method, which indicates that it is directed to the "abstract idea" or concept itself, rather than a practical application of the idea. Therefore claims 1-10 are directed to nonstatutory subject matter under the "abstract idea" exception since method does not produce a physical transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Even if it might be determined that the claimed method can be characterized as producing a useful, concrete, tangible result, to be proper subject matter for patent eligibility, any useful, concrete, tangible result must be within the useful or technological arts. See e.g., In re Musgrave, 167 USPQ 280 (CCPA 1970); In re Foster, 169 USPQ

99 (CCPA 1971). The Constitution empowers Congress to promote the useful arts. The term "useful arts" has been equated with "technological arts" in a number of decisions. See e.g., In re Waldbaum, 173 USPQ 430 (CCPA 1972).

In this case, the claimed invention is not within the useful or technological arts. Rather, the invention is within the realm of the liberal arts or social sciences. In Musgrave and Foster, the inventions were deemed to be within the technological arts. In those cases, each invention clearly involved computer or machine technology. But here, there is no technology involved at all. There is no technology disclosed or claimed. The "learning object" whether it is a toy, game story or something else is a peripheral element to the actual process and cannot reasonably convert an otherwise non-statutory process outside the technological arts into one that is in fact within the technological arts.

Claims 1-10 do not produce a useful, concrete, tangible result in the technological arts. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 1-10 do not define statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4 is rejected under 35 U.S.C. 102(e) as being anticipated by Curtin '271. Curtin discloses a set of educational cards and their method of use containing all of the elements of the claims including, selecting a learning object for use in teaching an emotional competency building block (page 3, paragraph 0021 clearly teaches that a teacher selects a target card to show a student and page 2, paragraph 0019 clearly teaches that the cards may be directed to emotional identification [considered to be a selected emotional competency building block] by a student), determining an activity utilizing the learning object that teaches the selected emotional building block (inherent with the device and method of Curtin), engaging the individual in the activity (described at page 3, paragraph 0021), identifying areas in which the individual needs reinforcement and if necessary repeating the activity (inherent with the method of Curtin and pointed to at page 3, paragraph 0021 where it states that "These exercises are repeated until the student shows a good grasp...", thus there must be an identifying step in order to establish whether the student has a good grasp or not otherwise the student needs reinforcement and the exercises are repeated) and defining the individual as having mastered the selected emotional competency building block (inherent in the method of Curtin and pointed to at page 3, last lines of paragraph 0021 where Curtin clearly states that by mastery of the exercises (i.e. emotional identification) the student becomes familiar with the topics being taught. Regarding the learning object being a toy as required by claim 3 or a game as required by claim 4, lacking any distinguishing

features it is considered that the cards of Curtin read onto both of the above limitations as they function as both toys and games.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-5, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stamm et al '975 in view of Curtin '271. Stamm discloses a system and method where caregivers interact with children to foster brain development including emotional development (pages 4-5, paragraphs 0034-0044) through determining an appropriate activity by using appropriate activity cards 200 and engaging the user with a selected one of a variety of activity items (i.e. learning objects) 104, for example see page 15, paragraphs 0134-0141. A learning object being a toy or game as required by claim 3-4, respectively are described at page 3, paragraph 0026. A learning object being a story, as required by claim 5, is described throughout the specification including at page 3, paragraph 0026 and at page 8, paragraph 0069. The device being geared for users in the age range of 3-5 is described at page 2, paragraph 0015 and figure 4A.

Stamm fails to explicitly teach the steps of identifying areas in which the individual needs reinforcement and if necessary repeating the activity or otherwise

defining the individual as having mastered the selected emotional competency building block as required by claim 1. However Curtin discloses a device and method for teaching concepts related to emotions where Curtin implicitly teaches that is known to include the steps of identifying areas in which the individual needs reinforcement and if necessary repeating the activity (inherent with the method of Curtin and pointed to at page 3, paragraph 0021 where it states that "These exercises are repeated until the student shows a good grasp...", thus there must be an identifying step in order to establish whether the student has a good grasp or not otherwise the student needs reinforcement and the exercises are repeated) and defining the individual as having mastered the selected emotional competency building block (inherent in the method of Curtin and pointed to at page 3, last lines of paragraph 0021 where Curtin clearly states that by mastery of the exercises (i.e. emotional identification) the student becomes familiar with the topics being taught. Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include the above steps in the method of Stamm for the purpose of making sure that the student/user achieves a familiarity with the topics being taught.

Claims 1-2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherin '106 in view of Curtin '271. Sherin discloses a game (as required by claim 4)/kit and method for developing an individuals or a group of individuals emotional Intelligence (col. 1, lines 46-48) containing most of the elements of the claims including selecting a learning object for use in teaching an emotional competency building block

(the selection of the game kit is inherent with the device and method of Sherin), determining an activity utilizing the learning object that teaches the selected emotional building block (inherent with the device and method of Sherin and described as the activity of using the kit), engaging the individual in the activity (described at col. 4, lines 46-51). Regarding claim 4 and the requirement of a hierarchical series of emotional competency building blocks comprising in sequence, awareness of self and others, emotional management, empathy and compassion, self-motivation and optimistic thinking and management of peer relationships, it is the position of the examiner that Sherin's game encompasses all of the building blocks as required (i.e. awareness of self and others is a must in order to answer questions 1-7 in col. 3, lines 50+, emotional management is clearly encompassed in the game as demonstrated by question 5 in col. 3, lines 62-63, while empathy and compassion and management of peer relations are taught in questions 6 and 7 and self motivation and optimistic thinking are taught in questions 1-7 since it takes self motivation and optimistic thinking to complete the task as required), furthermore it is pointed out that applicants freely admit that the above building blocks as linked to emotional intelligence are well known in the art (see applicants specification at page 2, paragraph 0006.

Sherin fails to teach the steps of identifying areas in which the individual needs reinforcement and if necessary repeating the activity and defining the individual as having mastered the selected emotional competency building block. However, Curtin discloses a device and method for teaching concepts related to emotions where Curtin implicitly teaches that is known to include the steps of identifying areas in which the

individual needs reinforcement and if necessary repeating the activity (inherent with the method of Curtin and pointed to at page 3, paragraph 0021 where it states that "These exercises are repeated until the student shows a good grasp...", thus there must be an identifying step in order to establish whether the student has a good grasp or not otherwise the student needs reinforcement and the exercises are repeated) and defining the individual as having mastered the selected emotional competency building block (inherent in the method of Curtin and pointed to at page 3, last lines of paragraph 0021 where Curtin clearly states that by mastery of the exercises (i.e. emotional identification) the student becomes familiar with the topics being taught. Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include the above steps in the method of Sherin for the purpose of making sure that the student/user achieves a familiarity with the topics being taught.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curtin '271 in view of Reynolds '676. Curtin discloses all of the elements of the claims, as stated above, but for an identifying step utilizing an emotional intelligence scale to determine the individual's level of performance as required by claim 6, wherein the scale may comprise at least three separate levels of performance as required by claim 7. However Reynolds discloses an educational system incorporating concepts of emotional intelligence described at page 2, middle of paragraph 0040 which states "...the invention can increase three important types of intelligence...self understanding and understanding of others..." which teaches that it is known to provide a grade scale

with an educational system for the purpose of determining the users level of performance (page 2, paragraph 0023).

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtin '271. Curtin discloses all of the elements of the claims, as stated above, and including that the cards of his invention are drawn to a variety of specific emotions including happiness and sadness (page 2, middle of paragraph 0019) as required by claim 9, however Curtin fails to explicitly teach that his cards are drawn to emotions of anger, pride and fear as required by claim 9 or to emotions of jealousy, surprise, worry, embarrassment and shyness as required by claim 10. It would have been obvious to including all of the above emotions with the device and method of Curtin for the purpose of teaching a wide number of well known emotions, since the examiner takes official notice that all of the above emotions are notoriously well known to be demonstrated or taught in the art (i.e. see Aduvala U.S. Patent No. 5,741,137 for an example of cards teaching more emotions at col. 4, lines 12-23) and since Curtin clearly places no limit on the emotions taught by his invention.

## ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-273-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Dmitry Suhol